

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Art Unit: 1654
)	
DJURUP, et al.)	Examiner: GUDIBANDE, S.
)	
Serial No.: 10/524,434)	Washington, D.C.
)	
Filed: February 15, 2005)	September 18, 2008
)	
For: BACTERICIDAL, ANTI-)	Docket No.: DJURUP=1
APOPTOTIC, PRO-)	
INFLAMMATORY AND...)	Confirmation No.: 4128

PRE-APPEAL BRIEF REQUEST FOR REVIEW

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building, Mail Stop AF
401 Dulany Street
Alexandria, VA 22314

S i r :

This request is filed pursuant to the New Pre-Appeal Brief Conference Pilot Program, published in the OG July 22, 2005. A notice of appeal was filed on even date herewith.

The sole issue in this case is that of written description support for the limitation

wherein at least one of the following conditions applies:

- (a) X19 is Arg or Ala,
- (b) X9 is Pro, Arg, or Gln,
- (c) X19 is Gln and X1 includes Pro,
- (d) X19 is 2-5 amino acid residues, or
- (e) X10 is Asn or Gln.

1. The Examiner concedes only that there is *ipsis verbis* support for the limitation "that when X1 includes Pro then X19 is Gln". We respectfully urge that this shows specific contemplation of the combination X19 is Gln and X1 includes Pro, and hence of proviso (c). Note that (c) is the converse of the existing proviso.

X19=Q and X1 includes proline is specifically supported by the mutants SID 593, 601 and 602. Also note that in SID596, 598 and 600-3, X1 includes Pro. For the convenience of the reviewing panel, it is noted that all sequences cited herein are aligned on pages 8-9 of the December 17, 2007 amendment.

2. With regard, individually, to provisos a, b, d and e,

we respectfully submit that it is not new matter to claim a subset of explicitly described alternative elements.

Plainly, if a claim said that a particular element A could be any of alternatives A1, A2, A3 or A4, it would not be new matter to limit the claim so A=A1. And one could logically present separate independent claims in which A=A2, A=A3 and A=A4, respectively.

Likewise, the applicant could choose to so claim, e.g., A=A1 and A=A2 but not A=A3 and A=A4.

That established, there is no change in the collective scope of the claims if the applicant were to claim A=A1 or A=A2 in a single claim rather than in two separate independent claims, and thus a claim to a subset of two or more disclosed alternatives does not violate the written description requirement.

Indeed, MPEP 2173.05(i) takes this principle a step further. If applicant disclose a genus, and more than one species belonging to that genus, they have written description for the explicit exclusion, from the claimed genus, of any of the positively recited alternative species. If an exclusion of any positively recited species is proper, than surely it is proper to simply claim just the desired alternatives in positive form.

3. Let us first consider proviso "a" (X19 is Arg or Ala). The original definition of X19 was "X19 can be represented by a sequence consisting of 2-5 amino acid residues or a single amino acid residue selected from Groups 5, 2 or 4". Group 5 is defined as being one of 17 amino acids, and includes both Arg and Ala. We amended X19 to eliminate the superfluous references to groups 2 and 4, which are actually subsets of group 5.

There is specific disclosure of both X19=Arg (R) and X19=Ala (A). X19=R is supported by the pHBP (20-44) mutants which feature the mutation Q44R, e.g., SID 593, 595 (the originally elected species), 596, 597, 598, 600. X19=A is supported by SID 604 and 606.

4. Proviso (b) requires X9=Pro, Arg, or Gln. The original claim allowed X9 to be any group 5 residue.

However, all three X9 alternatives are specifically disclosed. X9=P is supported by the pHBP (20-44) mutants with A33P, i.e., 593, 597, 598 and 600-3; the HNE-based sequence SID 604 also satisfies X9=P. X9=R is supported by hHNE (20-44) derived sequence SID 605. X9=Q is supported by the EAA01962 (20-44) derived sequence SID 606.

5. Proviso (d) requires that X19 is 2-5 aa, and as we stated in the discussion of proviso (a), this was one of the alternatives explicitly recited for X19 in original claim 1. It is exemplified by SID599.

6. Finally, proviso (e) requires that X10 is Asn (N) or Gln (Q). X10 was originally required to be an amino acid of groups 2 (Arg, Lys), 3 (His, Ile, Leu, Met, Phe, Pro, Thr, Val, Trp, or Tyr) or 4 (Asn, Gln), i.e., one of 14 amino acids. We first point out that since the proviso (e) choices are from, and only from, group 4, that proviso (e) effectively limits X10 to the defined amino acid group 4, for which subset of AAs there is thus explicit recognition. X19 being Asn is supported by SID604 and 605, and being Gln by SID603.

7. It follows from the foregoing that we have written description for five independent claims, the first reciting proviso (a); the second, proviso (b); and so forth. Consequently, it cannot be violation of written description to combine these five hypothetical independent claims into a single claim, like the present claim, whose scope is no greater than what those five hypothetical claims would have, collectively.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By: 
Iver P. Cooper
Reg. No. 28,005

624 Ninth Street, N.W.
Washington, D.C. 20001
Telephone: (202) 628-5197
Facsimile: (202) 737-3528

IPC:lms G:\ipc\g-i\hoib\DJurup1\DJurup1.pto preaappealbrief.wpd